

GP



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09/838,983	04/20/2001	David A. Hughes	SNY-P4339	1235

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MILLER PATENT SERVICES
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EXAMINER

BATURAY, ALICIA

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

GP

Office Action Summary

Application No.

09/838,983

Applicant(s)

HUGHES ET AL.

Examiner

Alicia Baturay

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/16/2004, 2/15/2004
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-51 are pending.

Drawings

2. The drawings are objected to because label 500 is referred to in the specification but not shown on Figure 15. It is believed that Applicant meant to use 500 instead of the underlined 520 within the "ENTERPRISE NETWORK" section of Figure 15. Additionally, label 502 is discussed in the specification but not shown on Figure 15. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: on page 8 of the specification, in the discussion of Fig. 6, "extracting a sample segment from file 150 of FIGURE 3 in file 170 of FIGURE 4" is not clear. Additional, on page 9, "Control then passes to 292 as previously" does not contain a subject. Appropriate correction is required.

Claim Objections

4. Claim 31 objected to because of the following informalities: in the last paragraph, the phrase "a audio sample" is cited as an improper use of the article. The phrase should read "an audio sample." Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 17 and 36 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 and 8 of U.S. 6,670,537.

As to claim 1, U.S. 6,670,537 claim 1 discloses a method of transmitting an audio sample comprising of launching an email application to generate a message, attaching a sample audio selection to the email, and sending the email. Claim 1 does not directly disclose the user attaching the sample via a single command. However, claim 8 states that a single command initiates the launching, generating, attaching and sending commands. It would have been obvious to one skilled at the art at the time the invention was made to combine the two claims because the authors of both applications themselves did so.

As to claim 17, U.S. 6,670,537 claim 1 discloses an email application that generates and sends an email message and attaching a sample of the audio selection to the email. Claim 1 does not directly disclose the user attaching the sample via a single command. However, claim 8 states that a single command initiates the launching, generating, attaching and sending commands. It would have been obvious to one skilled at the art at the time the invention was made to combine the two claims because the authors of both applications themselves did so.

As to claim 36, U.S. 6,670,537 claim 1 discloses a platform for generating an email message and attaching a sample of the audio selection to the email. Claim 1 does not directly disclose receiving a single command to attach an audio sample. However, claim 8 states that a single command initiates the launching, generating, attaching and sending commands. It would have been obvious to one skilled at the art at the time the invention was made to combine the two claims because the authors of both applications themselves did so.

7. Claims 2-6 and 8 of patent # 6,670,537 contain every element of claims 2-8, 10-15, 18-23, 25-30, 32-35, 37-41, 43-46, and, 48-51 of the instant application and as such anticipate claims 2-8, 10-15, 18-23, 25-30, 32-35, 37-41, 43-46, and, 48-51 of the instant application.

“A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F .2nd at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F .3d at 1437, 46 USPQ 2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus. “ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 2, 8-10, 17, 18, 24, 25, 32, 36, 37, 41-43, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over “A guide to using MS Mail on PTOnet” (hereafter “Microsoft Mail”) and Hurtado et al. (U.S. 6,611,182).
10. As to claim 1, Microsoft Mail discloses receiving a single command from the sender to attach a file (Microsoft Mail, page 13, top figure, note “Attach” button) and attaching the file (Microsoft Mail, page 13, top figure, note “Request.doc” file is attached). But Microsoft Mail fails to disclose a method of transmitting audio samples using electronic mail. However, Hurtado teaches that music sample tracks can be emailed between end users (Hurtado, col. 83, line 59; col. 87, lines 1-2). It would have been obvious to combine the teachings of Microsoft Mail and Hurtado to facilitate the distribution of sample music files that would lead to sources of revenue through redistribution of content (Hurtado, col. 2, line 3).
11. As to claims 2, 10, 18, 25, 32, 37, 43, and 48, the combination of Microsoft Mail and Hurtado (Microsoft Mail-Hurtado) discloses the invention substantially as described in claim 1, including a compressed audio sample (Hurtado, Fig. 18, #1810; col. 87, lines 1-3).

12. As to claims 8 and 41, Microsoft Mail-Hurtado discloses the invention substantially as described in claim 1, including the single command of clicking on an icon (Microsoft Mail, page 13, top figure).
13. As to claim 9, Microsoft Mail-Hurtado discloses the invention substantially as described in claim 1, but it does not explicitly disclose automatically attaching an audio sample to an email. Forwarding a message is a standard feature within most email programs. Additionally, when one chooses to forward a previously created email message that includes attachments, those attachments are already attached to this new email. It would have been obvious to use this forwarding feature in Microsoft Mail-Hurtado in order to facilitate the ease of use sender's spreading of the music sample and to facilitate the distribution of sample music files that would lead to sources of revenue through redistribution of content (Hurtado, col. 2, line 3).
14. As to claim 17, claim 1 is a method performing the same functions as claim 17. Therefore paragraph 10 of this Office Action discloses all of the limitations of claim 17.
15. As to claim 24, Microsoft Mail-Hurtado discloses the invention substantially, including attaching files to all emails. Microsoft Mail permits the use of automatic signatures, which are automatically added to the end of an outgoing email message. Microsoft Mail, as taught by the primary reference ("Microsoft Mail"), is a Windows-based email application program

and can be installed in end-users' PCs that running on operating systems such as Windows 98, Windows NT etc. Use of Microsoft Mail is therefore considered general knowledge available to one of ordinary skill in the art at the time of invention because Windows 98 and Windows NT were available in the marketplace on or before 1998. It would have been obvious to adapt this feature to allow an audio file as a signature so a user could easily redistribute the file and this would lead to sources of revenue through redistribution of content (Hurtado, col. 2, line 3).

16. As to claim 36, claim 1 is a method performing the same functions as claim 36. Therefore paragraph 10 of this Office Action discloses all of the limitations of claim 36.

17. As to claim 42, claim 9 is a method performing the same functions as claim 42. Therefore paragraph 13 of this Office Action discloses all of the limitations of claim 42.

18. Claims 3, 5, 6, 11, 13, 14, 16, 19, 21, 22, 26, 28, 29, 31, 33-35, 38-40, 44-47, and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Mail-Hurtado and in further view of Fritsch (U.S. 6,233,682).

19. As to claims 3, 6, 11, 14, 19, 22, 26, 29, 33, 35, 38, 40, 44, 46, 49, and 51, Microsoft Mail-Hurtado discloses the invention substantially as described in claim 2, but do not explicitly teach an audio sample comprising of a link to purchase. Fritsch teaches purchase of music files over the Internet (Fritsch, col. 4, lines 58-60). The link to the source of purchase is a

link to a website, and it is therefore inherent that the link comprises a URL. It would have been obvious to one of ordinary skill at the time the invention was made to combine Microsoft Mail-Hurtado and Fritsch (Microsoft Mail-Hurtado-Fritsch) to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

20. As to claims 5, 13, 21, 28, 34, 39, 45, and 50, Microsoft Mail-Hurtado discloses the invention substantially as described in claim 1, but do not explicitly teach a link to streaming music. Fritsch teaches clicking and listening to a song off of a website (Fritsch, col. 4, lines 49-58). Figure 1C shows a user "pre-listening" to a song on a web page; it is inherent the music is streaming. It would have been obvious to one of ordinary skill to combine Microsoft Mail-Hurtado with Fritsch to encourage the listening of samples to lead to purchase the song (Fritsch, col. 4, lines 58-60).

21. As to claim 16, Microsoft Mail-Hurtado discloses the invention substantially as described in claim 1, but it does not explicitly indicate that a server is being used to distribute the emails. However, Fritsch describes a network-based system for distribution of musical products over a network which includes a server for processing user requests and a database for storing digitized songs (Fritsch, col. 3, lines 4-13). Microsoft Mail, as taught by the primary reference ("Microsoft Mail"), is a Windows-based email application program and can be installed in end-users' PCs that are connected to servers running on operating systems such as Windows 98, Windows NT etc. Use of a server to distribute emails, including Microsoft

Mail-based emails, is therefore considered general knowledge available to one of ordinary skill in the art at the time of invention because Windows 98 and Windows NT were available in the marketplace on or before 1998. Therefore it would have been obvious to incorporate Fritsch's server in the Microsoft Mail-Hurtado system to be able to distribute music titles to end users on a large scale, i.e., sending song samples via automatic email attachment from the server processing user requests and the database. A person of ordinary skill would be motivated in view of the Fritsch teaching that this would facilitate users easily and quickly purchasing music (Fritsch, col. 1, line 25-26).

22. As to claim 31, Microsoft Mail-Hurtado teaches an electronic mail application that can generate email messages (Microsoft Mail, page 2, bottom figure; page 6, top figure), but Microsoft Mail-Hurtado does not directly disclose a computer network, an enterprise email server or a means on the mail server to attach a file to an outbound email. However, Fritsch discloses a network-based system for distribution of musical products over the Internet that includes a server for processing user requests that is connected to a database, which stores digitized songs (Fritsch, col. 3, lines 4-13). Use of a server to distribute emails, including Microsoft Mail-based emails, is therefore considered general knowledge available to one of ordinary skill in the art at the time of invention because Windows 98 and Windows NT were available in the marketplace on or before 1998. Therefore it would have been obvious to incorporate Fritsch's server in the Microsoft Mail-Hurtado system to be able to distribute music titles to end users on a large scale, i.e., sending song samples via email attachment from the server processing user requests and the database. A person of ordinary skill would

be motivated in view of the Fritsch teaching that this would facilitate users easily and quickly purchasing music (Fritsch, col. 1, line 25-26).

23. As to claim 47, claim 31 is a system performing the same functions as claim 47. Therefore paragraph 22 of this Office Action discloses all of the limitations of claim 42.

24. Claims 4, 7, 12, 15, 20, 23, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Mail-Hurtado-Fritsch and in further view of Kang (U.S. 2001/0051925).

Microsoft Mail-Hurtado-Fritsch discloses the invention substantially as described in claim 3, but does not explicitly disclose an affinity credit being awarded to the sender (Kang, paragraph 30). Kang and Hurtado both teach distribution of content via email (Kang, paragraph 29; Hurtado, col. 87, lines 1-2), and it would have been obvious to those skilled in the art at the time the invention was made to combine Kang's affinity credits with Hurtado's distribution of samples to encourage the wide distribution and purchase of content (Kang, paragraph 29).

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (703) 305-8865. The examiner can normally be reached on 7:15am - 3:45pm, Monday - Friday. The examiner will be moving in mid-October and can be reached then at (571) 272-3981. The Tech Center main telephone number will be (571) 272-2100.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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